

Application No.: 09/598,538**Docket No.: 5000-034****REMARKS**

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested.

Claim status

Claims 1-13, 18, 20-24 and 26-35 are pending in the application. Claims 1, 18, and 20-22 are amended. Claim 1 is amended to clarify claim language and remove previously inserted dependent claim language. Claims 18 and 20-22 are amended to correct minor grammatical errors. New claims 31-35 are added to secure an appropriate scope of protection to which Applicant is believed entitled.

The indication of allowable subject matter in claims 9-13, 18, 20-22, 24, and 27-30 is noted with appreciation.

Claims 1-3, 5-8, 23, and 26 are patentable over Xu et al. (U.S. Patent 6,401,027) in view of Holland (U.S. Patent 6,321,091)

The rejection of claims 1-3, 5-8, 23 and 26 under 35 U.S.C. 103(a) as being unpatentable over Xu et al. (6,401,027) in view of Holland (6,321,091) is hereby traversed. Neither the applied combination of references, nor the references alone, render obvious the claimed subject matter.

First, Xu fails to disclose at least the step of automatically communicating the street attribute of the vehicle to the remote location based upon a change in street attribute. Xu discloses transmitting position data of the vehicle to a communication station without reference to the communication being based upon a change in street attribute from the first location to the second location. Xu at column 7, lines 32-53. For at least this reason, withdrawal of the rejection of claim 1 is respectfully requested.

The Office Action admits that Xu fails to disclose communicating the location of the vehicle at a first and second frequency. At most, Xu admits that a single frequency (predetermined interval) is used to transmit the vehicle position. Xu at column 5, lines 6-7. Contrary to the Office Action, Xu's mention of "radio-frequency" is not the same as the claimed interval frequency of claim 1.

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Second, Holland fails to cure the noted and admitted deficiencies of Xu as Holland fails to disclose communicating a street attribute based upon a change in street attribute. Holland describes the transmission of positional data based on a change in the positional data, i.e., "positional data . . . includes latitude, longitude, and altitude information." Holland at column 7, lines 5-7. Holland alone, or in combination with Xu, fails to disclose communication of a street attribute based on a change in street attribute. As identified above, Holland communicates positional data and not a street attribute. For at least this reason, withdrawal of the rejection of claim 1 is respectfully requested.

Based on the foregoing, claim 1 is patentable over Xu in view of Holland and withdrawal of the rejection is respectfully requested.

Claims 2-3, 5-8, 23, and 26 depend, either directly or indirectly, from claim 1, include further important limitations, and are patentable over Xu in view of Holland for at least the reasons advanced above with respect to claim 1. The rejection of claims 2-3, 5-8, 23, and 26 should be withdrawn.

Claim 6

Further, with specific reference to claim 6, the Office Action appears to imply an inherency argument with respect to suppressing communication of a third location. There is no support for the inherency assertion in Holland. It is noted that the Office Action admits that Holland states that "if the locator device is relatively stationary, the rate of periodic transmission is reduced." Holland at column 2, lines 35-36. Based on the plain words of Holland, there is no suppression of communication of the third location. Reduced is not the same as suppressed. Even if the communication rate is reduced, the communication still occurs. For at least this reason, withdrawal of the rejection is respectfully requested.

In order to rely upon a theory of inherency, the Examiner is required to provide a factual basis and/or technical reasoning reasonably supporting the determination that the allegedly inherent characteristic necessarily flows from the prior art teaching. See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 169 F.3d 743, 745, 49 USPQ3d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present." Rosco v. Mirror Lite, 304 F.3d 1373, 1380 (Fed. Cir. 2002). The Examiner has failed to support

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the inherency assertion regarding the suppression of communication of a third location.

Claim 4 is patentable over Xu in view of Holland and further in view of Zijderhand (U.S. Patent 5,598,167)

Claim 4 depends indirectly from claim 1 and is patentable over Xu in view of Holland and Zijderhand for at least the reasons advanced above with respect to claim 1. For at least this reason, withdrawal of the rejection of claim 4 is respectfully requested.

Further, the Office Action fails to identify any motivation or suggestion in either reference teaching, suggesting, or describing the asserted combination. The Office Action asserts without reference to any reference that a person of ordinary skill in the art would have been motivated to combine the references in order to provide information about the actual location of a vehicle as it moves over streets.

The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness. A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. See MPEP 2143.01 quoting Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The Office Action merely stated that the reference can be modified, which Applicant contend to the contrary, and does not state any desirability for making the modification. In other words, the Office Action failed to supply any objective reasons to modify the applied reference.

“When an obviousness determination is based on multiple prior art references, there must be a showing of some ‘teaching, suggestion, or reason’ to combine the references.” Winner International Royalty Corp. v. Wang, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000). The PTO has failed to make such a showing supporting the applied combination of references and therefore the applied combination of references is improper. The PTO is in error for any of the above reasons and has not made out a prima facie case of obviousness, and the rejection of claim 4 should be reversed.

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Based on the foregoing, withdrawal of the rejection of claim 4 is respectfully requested.

All objections and rejections having been addressed, it is respectfully submitted that the present application should be in condition for allowance and a Notice to that effect is earnestly solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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